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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/594,839	06/15/00	ANTHONY	J 2629-4017

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HM12/0719

EXAMINER

CHUNDURU, S

ART UNIT

PAPER NUMBER

1656

DATE MAILED:

07/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/594,839

Applicant(s)

ANTHONY ET AL.

Examiner

Suryaprabha Chunduru

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Supplemental Action

1. The previous office action has been withdrawn in view of the telephonic interview. The Restriction of groups is re-written as following:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 48 and 49, drawn to a method of detecting a target nucleic acid using a ligand, classified in class 435, subclass 6.
- II. Claims 22-46, drawn to a method of detecting a target nucleic acid using antibody, classified in class 435, subclass 7.2.
- III. Claim 47, drawn to a nucleic acid probe requiring SEQ ID Nos. 1-160, classified in class 536, subclass 24.3.
- IV. Claims 50-55, drawn to a method of detecting a nucleic acid using a sequence repeat probe, classified in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Group III is independent from each of Groups I, II and IV because the nucleic acid probes, are materially different from (a) the invention in Group I which involves hybridization method steps with specific capture sequence probe and signal sequence probe and the hybrid formed with the target is detected using a ligand (b) the methods of Group II which involve hybridization with specific capture sequence probe and signal sequence probe and the hybrid formed with the target is detected using antibody (c) the invention in Group IV involves hybridization method steps with specific capture sequence probe, signal sequence probe and bridge probe with repeat sequences. The nucleic acid probes of Groups III may be obtained from naturally occurring sources or may be synthesized chemically. Neither are any of the methods for

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detecting target nucleic acid steps claimed in Groups I or II or IV needed to produce or practice the invention of Group III.

Group IV is independent and distinct from each of Groups I and III because the method of identifying a target nucleic acid using repeat sequence bridge probe of Group IV can be used in materially different processes such as mutation detection and the method of identifying target nucleic acid using ligand of Group I may be processed in materially different assays such as receptor ligand-binding assays. Neither are any of the methods claimed in Groups I or IV needed to practice the invention in Group III.

Group II is independent and distinct from each of Groups I and III because the method of identifying a target nucleic acid using antibody label of Group II can be used in materially different processes such as antigen-antibody assays and DNA-protein interaction assays and the method of identifying target nucleic acid using ligand of Group III may be processed in materially different assays such as polymerase chain reaction. Neither is any of the methods claimed in Groups III or I needed to practice the invention in Group II.

Because the inventions are distinct for the reasons given above and have acquired a separate status in the art as shown above, restriction for examination purposes as indicated is proper.

In this application additionally, if applicant elects Group III, applicant is required to specify one specific nucleotide sequence for examination. This requirement is made under 1192 O.G. 68 Notice (November 19, 1996 and revised MPEP), as the examination of more than one sequence in one application would result in an undue search burden on the PTO sequence search mission.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

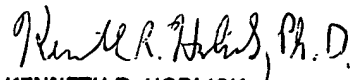
Applicant is reminded that upon the cancellation of claims to non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Suryaprabha Chunduru
July 18, 2001


KENNETH R. HORLICK
PRIMARY EXAMINER 7/18/01
GROUP 1600